

REMARKS

This paper responds to the Office Action dated October 10, 2006. In that action, each of pending claims 1-34 was rejected as obvious over a combination of three or more references. Three of the claims were also rejected under 35 U.S.C. § 112 for lacking antecedent basis. Several claims have been amended herein to address the rejections based on antecedent basis, as have several additional amendments to address antecedent basis issues identified by the Applicant.

Rejections Under Section 103

Each of the pending claims has been rejected under some combination of: (1) Sakayori Japanese Patent Publication No. 5-22428, U.S. Patent 4,351,986 to Fachalos, and U.S. Patent 6,310,609 to Morgenthaler; (2) Sakayori, Fachalos, Morgenthaler, and U.S. Patent 4,363,936 to Christian; (3) Sakayori, Fachalos, Morgenthaler, and U.S. Patent 6,031,465 to Burgess; (4) Sakayori, Fachalos, Morgenthaler, and U.S. Patent 5,938,772 to Welch; (5) Sakayori, Fachalos, Morgenthaler, and U.S. Patent 5,153,590 to Charlier; (6) Sakayori, Fachalos, Morgenthaler, and U.S. Patent 6,223,233 to Kavanaugh; (7) U.S. Patent 5,570,025 to Lauritsen and U.S. Patent 6,405,032 to Buhrmann; and (8) Sakayori, Fachalos, Morgenthaler, and U.S. Patent 5,612,995 to Corwith.

With respect to the rejections based on the Sakayori reference, the relevant independent claims are claims 1, 18, and 20. Claim 1 recites a telephone set that includes a voice message alert and retrieval device separate from the phone's dialing keys, with a message waiting light source showing through a message key that is responsive to a voice message waiting signal. The claim also recites that the message key has a distinct visual impression (e.g., is larger in size or different in shape) apart from its emission of visible light, compared to its adjoining keys. Claims 18 and 20 include similar features (e.g., a message alert and retrieval device having a shape that differs from the shape of the telephone dialing keys, and a message access key that is shaped differently than and positioned away from other keys). (The Office Action discusses

claim 19 with respect to Sakayori but does not list it as one of the rejected claims; nonetheless, the arguments here also apply to claim 19).

As an initial matter, the Office Action says nothing about the feature, in both independent claims, that the device differ visually from the other keys or buttons on a telephone set. This feature permits the quick identification of the message retrieval device as using a button or key that has a special function, and as discussed in the original application, permits users in unfamiliar surroundings (such as hotel rooms) to quickly identify the device as something special and particularly relevant. The applied references provide no such disclosure. The Sakayori reference simply shows identical rectangular keys, while the Fechalos patent shows three different grids of identical buttons. The Office Action relies on Morgenthaler simply as showing lighted telephone keys, and does not identify any other relevant disclosure in any of the other references that are applied to dependent claims.

This is also not simply a matter of design choice. Indeed, a skilled artisan would be motivated by interests of economy and design to use identical keys, as does each of the applied references. Consistent use of keys in such circumstances provides a more integrated visual look for a telephone, and also lowers costs by permitting use of common parts. Thus, nothing in the references or in any evidence cited by the Office shows any motivation or reason for a skilled artisan to provide special treatment to a particular key or button on a telephone set. As a result, Applicant respectfully suggests that claims 1-18 and 21-34 are in condition for immediate allowance.

The bases actually provided in the Office Action also do not make out a prima facie case of obviousness. In short, the Office's position is that Sakayori discloses a multi-function telephone and that Fechalos discloses that lights may generally be integrated with buttons on a telephone. These two points do not, however, lead to the invention of the pending claims. Rather Fechalos simply indicates that a light may be energized to indicate that a certain function (e.g., hold) on a telephone has been selected by a user – essentially on “on/off” indicator for a button. See Fechalos, col. 10, lines 37-67. The purposes of provided an indicator light in the present claims is wholly different, and not disclosed or suggested anywhere in Fechalos.


Specifically, the light indicates a state of the central messaging system in a telephone system, and not whether a particular feature has been selected or not selected by a user. The light is controlled, not by the user, but by a messaging system. This alerting application in a selection button is wholly different from the on/off function discussed in Fechalos, and Fechalos or the other applied references do not teach or fairly suggest this feature that is recited in the pending claims. As a result, Applicant respectfully submits that the claims are in condition for immediate allowance.

Claims 19 and 20 stand rejection as obvious in light of the Lauritsen and Buhrmann references. Lauritsen fails to teach or suggest any relevant features for the reasons discussed above with respect to the other applied references, and the Office Action appears to recognize as much. As for Buhrmann, it shows nothing relevant to the features discussed above, because it provides nothing but schematic diagrams – so no conclusion can be made about the relevant sizes or shapes of the actual implementation of Buhrmann. Moreover, the Office's rationale for combining these two references is fatally flawed and based solely on the hindsight provided by Applicant's invention. Specifically, the practical importance of providing the message retrieval key or button as a feature that stands out from other keys or buttons is discussed above. Thus, this is not a case in which mere design choice is involved, but is instead one in which the difference is practical, substantive, and important. In fact, MPEP 2144.04, to which the Office Action refers, cites *Ex parte Hilton*, 148 USPQ 356 (Bd. App. 1965), for the proposition of "Claims were directed to fried potato chips with a specified moisture and fat content, whereas the prior art was directed to french fries having a higher moisture content. While recognizing that in some cases the particular shape of a product is of no patentable significance, the Board held in this case the shape (chips) **is important because it results in a product which is distinct from the reference product (french fries).**" Likewise, here the particular shape and size of the message retrieval key or button is important because it provides an advantage that is not provided even by the hindsight-induced combination of prior art references. As a result, Applicant respectfully submits that claims 19 and 20 are also in condition for immediate allowance.

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Respectfully submitted,

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